Decision for dispute CAC-UDRP-103450

Case number	CAC-UDRP-103450
Time of filing	2020-12-08 09:58:02
Domain names	simonesoldes.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	SIMONE PERELE

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Name	Liling Weng

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks. The Complainant adduced evidence for the following:
- International trademark No. 272755 for “SIMONE PERELE”, registered on 9 August 1963 in Class 25 under the Nice Classification;
- European trademark No. 4367512 for “SIMONE PERELE”, registered on 30 March 2005 in class 25; and
- European trademark No. 18269546 for "SIMONE & SIMONE PERELE", registered on 8 July in classes 24, 25 and 26.

The Complainant adduced evidence showing that it is also the registrant of the domain name <simone-perele.com> registered on 7 August 1997.

In addition, the Complainant claimed, without providing evidence, that it holds other trade marks and mentioned specifically a European trademark No.13026216 for "SP SIMONE PERELE PARIS", registered on 24 June 2014.

The Respondent registered the disputed domain name <simonesoldes.com> on 15 July 2020.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Respondent purports to sell "SIMONE PERELE" products on its website associated with the disputed domain name. This is shown by screenshots comparing the Complainant's website with the Respondent's site. In the screenshots of the latter, copies can furthermore be seen of the Complainant's own site layout, logo (in the form "SIMONE PERELE PARIS") and product catalogue images and descriptions. Both sites are in French.

No licence or authorization has been granted by the Complainant to the Respondent to make any use of the Complainant’s trademark or to apply for registration of the disputed domain name.

A test purchase conducted by a bailiff on the Complainant's behalf, which was adduced in evidence, shows that when a product was ordered via the Respondent's website and paid for, it was not delivered. Instead, the Respondent sent a completely different product bearing another brand to the person assisting the bailiff for the test purchase.

The contact email address given on the Respondent's website, “helpdesk@customerservicebest.com”, is used for scamming purposes in other instances, as shown by a fraud alert to consumers posted online by a third-party scam review website.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The term "SIMONE" in the disputed domain name makes reference to the name of Complainant and is confusingly similar to it. Addition of the term "SOLDES" is not sufficient to escape the finding that the domain name is confusingly similar to the Complainant's trademark and does not change the overall impression of the designation as being connected to the trademark.

Furthermore, addition of the French term "SOLDES" (“sales”) in the disputed domain name increases the likelihood of confusion with the Complainant’s trademarks and activity because “SOLDES” refers to the Complainant's trading activity. Previous Panels have held that the addition of words can worsen the confusing similarity between a trademark and a domain name (for example, WIPO Case No. D2010-2124, Costco Wholesale Corporation and Costco Wholesale Membership, Inc. v. Kenneth Terril).

The Respondent's use of the disputed domain name with its website in the circumstances described does not grant the Respondent rights or legitimate interests in the disputed domain name (see WIPO Case No. D2019-1048 CuraLife LTD v. Domain Protection Services, Inc. / Robert Anderson).

Instead of the Respondent having any right or legitimate interest in the use of the Complainant's brand, the purchase test conducted on the Complainant's behalf provides proof that the Respondent's website is used to send other products to consumers than those ordered. The product sent by the Respondent bears the brand "VERSACE", meaning that this cannot be an instance of order error because the online store associated with the disputed domain name purports to sell only the Complainant's products.

This proof confirms that the Respondent registered and is using the disputed domain name in bad faith for the purpose of attracting internet users for commercial gain by creating a likelihood of confusion with the Complainant. The Complainant invokes the UDRP and Decisions by several previous ADR Panels in making this claim.

The Complainant in the course of its contentions clarifies that it cannot be excluded that the Respondent may be reselling some genuine products of the Complainant that have been placed on the market, but contends that this circumstance neither creates a legitimate interest in registering and using the disputed domain name nor dispels the element of bad faith demonstrated in this case.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under the UDRP were met and that there is no other reason why it would be inappropriate to provide a Decision.

The Complainant invoked but did not adduce evidence for European trademark No.13026216 for "SP SIMONE PERELE PARIS". Normally, such an omission could be to the detriment of a Complainant's case if the evidence in question is significant in establishing the basis for deciding the case. In this instance, the Panel records that the mention of the additional trademark adds little that is material in this Proceeding. The omission does not therefore affect the Panel's appreciation of the evidence substantiating the Complainant's rights as a whole.

PRINCIPAL REASONS FOR THE DECISION

This uncontested case concerns, as shown by compelling evidence, an elaborate online shopping scam aimed at consumers who seek to buy the Complainant's branded products online.

The Panel finds:

- that, for the purpose of the first criterion of the UDRP cumulative three-criteria test, the Complainant has demonstrated its own rights in the name "SIMONE PELENE" (see "Identification of Rights");

- but that it does not accept the Complainant's contention that the inclusion of the brand name element “SIMONE” is sufficient reference to the Complainant’s trademarks in the disputed domain name to warrant a finding of confusingly similarity, since “Simone” on its own is merely a commonly encountered first name;

- that the evidence the Complainant has submitted does show that the Complainant employs the brand name element “SIMONE” to refer to itself on its website, but that it combines this element with another word or phrase, such as in “MY SIMONE” when denoting a loyalty account or "JOURS DE SIMONE" when announcing periods when promotional discounts apply;

- that the brand name element “PERELE” is absent in the disputed domain name but that the word “SOLDES” (“sales” in English) is added in the name's stem after “SIMONE”, while the Respondent in addition chose the same TLD suffix ".com", as the Complainant had done for its e-shop website;

- that the Complainant’s trading activity of conducting "sales" is pertinent in assessing the presence of the UDRP's first-criterion element of confusing similarity in the circumstances of this case, and that the Respondent's combination of the

brand name element "SIMONE" with “SOLDES” directed specifically towards French-speaking customers can operate to increase the degree of similarity in the targeted consumers' minds;

- that a major purpose of trademark protection, which is itself afforded a level of protection under the UDRP, is to assure a channel between suppliers and their customers for purposes of recognition when forming commercial relationships;

- that the similarity of the disputed domain name to the Complainant's brand as explained in the findings above is capable of inducing some confusion with respect to that channel in this case;

- that this possibility of confusion was then greatly increased by the way in which the Respondent’s website mimics very closely that of the Complainant in order to induce the false impression that it is the Complainant’s website;

- that, in light of the above findings, the disputed domain name is confusingly similar to the Complainant’s protected brand;

- that, from the Case File, there is furthermore a strong likelihood that the Respondent is concealing its identity during the present Proceeding, having given as part of its address in Hong Kong the name of a location in the United States state of Alaska and a postal code for Hong Kong that appears in China’s postal code system but is not or is only rarely used in Hong Kong addresses themselves;

- that the Respondent in light of the above clearly has no right or legitimate interest in respect of the disputed domain name;

- that, in light of the foregoing, the Complainant has satisfied the UDRP’s second criterion; and

- that the above findings of an illegitimate purpose being pursued by egregious misuse the Complainant’s brand also require a finding of bad faith, so satisfying the third and final criterion of the UDRP test.

The Panel accordingly finds for the Complainant and orders the transfer of the disputed domain name to it.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **SIMONESOLDES.COM**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2021-01-16

Publish the Decision